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OFFICE OF PETITIONS

In re Patent No. 6,597,281 :
Issued: July 22, 2003 : ON PETITION
Application No. 09/675,177 :
Filed: September 29, 2000 :
Attorney Docket No. 99-1833 :

This is in response to the petition under 37 CFR 1.378(b), filed August 1, 2011, to accept the unavoidably delayed payment of the maintenance fee for the above-identified patent.

The patent issued on July 22, 2003. The patent expired on July 23, 2011, for failure to timely remit the second maintenance fee. On August 1, 2011, petitioner, Gerald L. Thomas, filed the present petition under 37 CFR 1.378(b) accompanied by the \$1,240.00 maintenance fee due at 7.5 years and the \$700.00 surcharge after expiration where late payment is unavoidable.¹

In the present petition, petitioner explained: "I had my years wrong, I thought I had until 1/22/12; I was checking my patent just days after it had expired: 7/22/11 and realized it was this year. I'm hoping to continue to mark my idea (patent) #6,597,281." *Petition, 08/01/11, p. 4.*

A grantable petition to accept a delayed maintenance fee payment under 37 CFR 1.378(b) must include the following:

(1) the required maintenance fee set forth in § 1.20(e) through (g);

(2) the surcharge set forth in § 1.20(i)(1); and

(3) a showing that the delay was unavoidable since reasonable care was taken to ensure that the maintenance fee would be paid timely and that the petition was filed promptly after the patentee was notified of, or otherwise became aware of, the

¹ Petitioner submitted \$1,280.00 for the payment of the maintenance fee due at 7.5 years. The Office notes that as of the mailing date of this decision, the small entity maintenance fee due at 7.5 years is \$1,240.00. Therefore, petitioner overpaid in the amount of \$40.00. The overpayment of \$40.00 will be refunded to petitioner by treasury check in due course.

expiration of the patent. The showing must enumerate the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which patentee became aware of the expiration of the patent, and the steps taken to file the petition promptly.

This petition lacks requirement (3).

As 35 U.S.C. 41(c) requires the payment of fees at specified intervals to maintain a patent in force, rather than some response to a specific action by the Office under 35 U.S.C. 133, a reasonably prudent person in the exercise of due care and diligence would have taken steps to ensure the timely payment of such maintenance fees. Ray v. Lehman, 55 F.3d 606, 609, 34 USPQ2d 1786, 1788 (Fed. Cir. 1995). That is, an adequate showing that the delay in payment of the maintenance fee at issue was "unavoidable" within the meaning of 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) requires a showing of the steps taken to ensure the timely payment of the maintenance fee. Id. Thus, where the record fails to disclose that the patentee took reasonable steps, or discloses that the patentee took no steps, to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR 1.378(b).

Acceptance of a late maintenance fee under the unavoidable delay standard is considered under the same standard for reviving an abandoned application under 35 U.S.C. 133. This is a very stringent standard. Decisions on reviving abandoned applications on the basis of "unavoidable" delay have adopted the reasonably prudent person standard in determining if the delay was unavoidable:

The word 'unavoidable' . . . is applicable to ordinary human affairs, and requires no more or greater care or diligence than is generally used and observed by prudent and careful men in relation to their most important business. It permits them in the exercise of this care to rely upon the ordinary and trustworthy agencies of mail and telegraph, worthy and reliable employees, and such other means and instrumentalities as are usually employed in such important business. If unexpectedly, or through the unforeseen fault or imperfection of these agencies and instrumentalities, there occurs a failure, it may properly be said to be unavoidable, all other conditions of promptness in its rectification being present.

In re Mattullath, 38 App. D.C. 497, 514-15 (1912) (quoting Pratt, 1887 Dec. Comm'r Pat. 31, 32-33 (1887)); see also Winkler v. Ladd, 221 F. Supp. 550, 552, 138 USPQ 666, 667-68 (D.D.C. 1963), aff'd, 143 USPQ 172 (D.C. Cir. 1963); Ex parte Henrich, 1913 Dec. Comm'r Pat. 139, 141 (1913). In addition, decisions on revival are made on a "case-by-case basis, taking all the facts and circumstances into account." Smith v. Mossinghoff, 671 F.2d 533, 538, 213 USPQ 977, 982 (D.C. Cir. 1982). Finally, a petition cannot be granted where a petitioner has failed to meet his or her burden of establishing that the delay was "unavoidable." Haines v. Quigg, 673 F. Supp. 314, 316-17, 5 USPQ2d 1130, 1131-32 (N.D. Ind. 1987). Moreover, patentee's lack of knowledge of the need to pay the maintenance fee and the failure to receive the Maintenance Fee

Reminder do not constitute unavoidable delay. See Patent No. 4,409,763, 7 USPQ2d 1798 (Comm'r Pat. 1988).

In determining whether the delay in paying a maintenance fee was unavoidable, one looks to whether the party responsible for payment of the maintenance fee exercised the due care of a reasonably prudent person. Ray v. Lehman, 55 F.3d 606, 608-609, 34 USPQ2d 1786, 1787 (Fed. Cir. 1995). The patent owner at the time of the expiration of the patent is ultimately the person responsible to ensure the timely payment of the maintenance fees. The patent owner may engage another to track and/or pay the maintenance fees; however, merely engaging another does not relieve the patent owner from his obligation to take appropriate steps to ensure the timely payment of such maintenance fees. See California Medical Prods. v. Tecnol Medical Prods., 921 F. Supp. 1219 (D. Del. 1995).

In this instance, petitioner was the patent owner at the time of the expiration of the patent, and therefore, he alone had an obligation to ensure the timely payment of the maintenance fee. The petition is completely silent as to the steps or tracking system that petitioner may have had in place to ensure that the maintenance fee was paid in a timely manner and how that system failed to alert petitioner of the due date for the second maintenance fee. Likewise, without documentary evidence that petitioner undertook calendaring or tracking of the maintenance fee due dates, petitioner has not shown unavoidable delay.

The required showing must set forth the steps taken to ensure timely payment of the maintenance fee, the date and the manner in which petitioner became aware of the expiration of the patent, and the steps taken to file the petition promptly. MPEP 2590. Furthermore, an adequate showing requires a statement by all persons with direct knowledge of the cause of the delay, setting forth the facts as they know them. Id. Copies of all documentary evidence referred to in a statement should be furnished as exhibits to the statement. Thus, where a patentee fails to show that he took reasonable steps, or discloses that he took no steps to ensure timely payment of the maintenance fee, 35 U.S.C. 41(c) and 37 CFR 1.378(b)(3) preclude acceptance of the delayed payment of the maintenance fee under 37 CFR 1.378(b).

In summary, the record fails to disclose that petitioner had a reasonably reliable system in place to track the maintenance fee due dates to ensure the timely payment of the second maintenance fee. Accordingly, the petition under 37 CFR 1.378(b) is dismissed.

Petitioner should note that if this petition under 37 CFR 1.378(b)/(e) is not renewed, or if renewed and not granted, petitioner may obtain a refund of the \$1,240.00 maintenance fee and the \$700.00 post-expiration surcharge. The \$400.00 petition fee for seeking further reconsideration is not refundable.

Any request for refund should be in writing to the following address:

Mail Stop 16
Director of the US Patent and Trademark Office
PO Box 1450
Alexandria, VA 22313-1450

A copy of this decision should accompany petitioner's request.

In the alternative, petitioner may wish to file a petition under 37 CFR 1.378(c), requesting that the Office accept the unintentionally delayed payment of the second maintenance fee. A petition under 37 CFR 1.378(c) must be filed within twenty four months from the end of the six month grace period (i.e. on or before July 22, 2013) and be accompanied by (1) a verified statement that the delay was unintentional, (2) payment of the appropriate maintenance fee, **unless previously submitted**, and (3) payment of the \$1,640.00 surcharge set forth in 37 CFR 1.20(i)(2).

Petitioner may request that the \$700.00 surcharge previously paid be credited toward the \$1,640.00 unintentional surcharge. Petitioner would be required to pay the difference of \$940.00. A copy of the form for a Petition to Accept the Unintentionally Delayed Payment of Maintenance Fee in an Expired Patent (37 CFR 1.378(c)) (Form PTO/SB/66) accompanies this decision for petitioner's convenience.

The Office notes that the address indicated on the petition differs from the address of record. As a one-time courtesy the Office will mail this decision to the address listed in the petition. However, if petitioner wishes to receive future correspondence concerning this patent, petitioner should submit a change of correspondence address. The appropriate form (Form PTO/SB/123) accompanies this decision for petitioner's convenience.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

By FAX: (571) 273-8300
Attn: Office of Petitions

By hand: Customer Services Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Correspondence may also be submitted electronically via EFS-Web.

Telephone inquiries regarding this decision may be directed to the undersigned at (571) 272-3211.

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Enclosures: Forms PTO/SB/ 66, PTO/SB/123

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